



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/591,032

07/23/2007

Maurizio Marini

6254.740

5814

44362

7590

03/03/2009

Pequignot + Myers LLC  
140 Marine View Avenue  
Solana Beach, CA 92075

EXAMINER

ARNETT, NICOLAS ALLEN

ART UNIT

PAPER NUMBER

3751

MAIL DATE

DELIVERY MODE

03/03/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/591,032	<b>Applicant(s)</b> MARINI, MAURIZIO	
	<b>Examiner</b> NICOLAS A. ARNETT	<b>Art Unit</b> 3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 August 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the stand of claim 5 and the non-return valve of claim 6 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

2. The disclosure is objected to because of the following informalities: on page 3, line 16 the word "undesible" appears to be a misspelling of "undesirable." Appropriate correction is required.
3. Claims 3, 7 and 9 are objected to because of the following informalities: in line 2 of claim 2, in lines 4 and 5 of claim 7 and in line 5 of claim 9, "fluidtight" should be "fluid-tight". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
  - a. Regarding claims 1-12, the phrase "in particular, tyres" in claims 1 and 7 render the claims indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
  - b. Claim 9 recites the limitation "said rod" in line 4. There is insufficient antecedent basis for this limitation in the claim. It appears to the examiner that claim 7 should depend from claim 4 rather than claim 1 to provide proper antecedent basis for this limitation.

- c. Claim 10 recites the limitation "a kit as claimed in claim 1" in line 1. There is insufficient antecedent basis for this limitation in the claim. Claim 1 does not claim a kit and it appears to the examiner that claim 10 should depend from claim 7 rather than claim 1.
- d. The phrase "or vice versa" in claims 4 and 9 render the claims indefinite because it is unclear what limitations are to be reversed.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 and 5-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication 2003/0056851 to Eriksen et al. (Eriksen).

Regarding claim 1, Eriksen discloses a container for sealing liquid for repairing inflatable articles (abstract) comprising a vessel (3) having an opening (opening shown in Figs. 10-15) and closing means (sealing 38 and plunger 46'), characterized in that said closing means comprise a valve device having an inlet (bores 59) connectable to a compressed-air feed line (via channel 29, see Figs. 13-15), and an outlet (opening shown in Fig. 14 whereby sealing liquid can flow from the container and into channel 30) for dispensing the sealing liquid. Eriksen further discloses said valve device (18) comprising at least one control member (plunger 46') movable, in response to

Art Unit: 3751

pressurization of said feed line ([0114] and Figs. 13-15), from a closed position closing said valve device and wherein said inlet and said outlet are closed by said control member (shown in Fig. 13), to an open position wherein said inlet and said outlet communicate with the inside of said container (shown in Figs. 14-15). Eriksen discloses the claimed invention except for said closing means is integrated in said container and housed into said opening. It would have been obvious to one having ordinary skill in the art at the time the invention was made to integrate the closing means into the opening of the container rather than into the dispensing device, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. In re Einstein, 8 USPQ 167.

Regarding claim 5, Eriksen discloses a stand (Figs. 10-15 show the container 3 held by a stand).

Regarding claim 6, Eriksen discloses a non-return valve (61).

Regarding claim 7, Eriksen discloses a kit for repairing inflatable articles (abstract) comprising a container as claimed by claim 1 and a dispenser unit (pneumatic cylinder 41) detachably connectable to said container (by threads on dispenser unit and container, see Figs. 13-15) and having an inlet fitting (fitting connected to channel 29) connected in fluid-tight manner to said inlet (see Figs. 13-15) of said valve device and an outlet fitting (fitting connected to channel 30) connected in fluid-tight manner to said outlet (see Figs. 13-15) of said valve device.

Art Unit: 3751

Regarding claim 8, Eriksen discloses that said dispenser unit screws onto a threaded neck of said container (see the threaded connection between the container and dispensing device in Figs. 13-15).

Regarding claim 9, Eriksen discloses that said dispenser unit comprises a cavity housing said container neck (see Figs. 13-15); said inlet and outlet fittings communicating with a bottom portion of said cavity (see Figs. 13-15) via an axial conduit (56') and a transverse conduit (29); and a rod (57) cooperating at the end in fluid-tight manner with an annular portion of a bottom wall (49) of said cavity surrounding said axial conduit (Figs. 13-15).

Regarding claims 10 and 11, Eriksen discloses a casing ([0061]) housing a compressor assembly (2) and having a seat for housing said container and said dispenser unit (see the case having a seat in Figs. 7-12), wherein said seat comprises a base portion (Figs. 7-12) having fastening means for securing said dispenser unit stably but detachably (Figs. 10-12 show screws as the fastening means).

Regarding claim 12, Eriksen does not disclose the fastening means comprising a bayonet connection. However, bayonet connections are known in the art as equivalent fastening means to screws. It would have been obvious to one of ordinary skill in the art at the time of invention to replace the screws of Eriksen with a bayonet connection as known equivalents for fastening.

8. Claims 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eriksen in view of US Patent 4,765,367 to Scott (Scott).

Regarding claim 2, Eriksen does not disclose elastic means for keeping said control member stably in said closed position in the absence of pressure to said inlet. Scott teaches a container for sealing fluid for repairing inflatable articles (abstract) including a valve (28) having a spring (44) to bias the valve to a closed position. It would have been obvious to one of ordinary skill at the time of invention to have included a spring according to the teachings of Scott in the valve of Eriksen to bias the valve to a closed position.

***Allowable Subject Matter***

9. Claims 3 and 4 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter: the prior art does not disclose nor render obvious a container for sealing liquid for repairing inflatable article as specified in claim 2 wherein said valve device comprises a body having at least one first hole and at least one second hole axially spaced apart and communicating with the inside of the container, said inlet and said outlet being defined by axial passages of said body, said control member being defined by a slide which slides axially in said body and has sealing means for isolating said first hole from said inlet and from said outlet in the close position and for isolating said first hole from said outlet and said second hole from said inlet in the open position.



***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NICOLAS A. ARNETT whose telephone number is (571)270-5062. The examiner can normally be reached on Monday - Friday 7:30 AM to 3:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Huson can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 3751

If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NAA

/Timothy L Maust/  
for Gregory Huson, SPE of Art Unit 3751